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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,306	10/15/2001	Denis O'Keeffe	09623C-036300US	4335
20350	7590	02/23/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SHENG, TOM V	
			ART UNIT	PAPER NUMBER
			2673	8

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,306

Applicant(s)

O'KEEFFE ET AL.

Examiner

Tom V Sheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 11-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 10, 14 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 15 recites the limitation "the cantilevered arm" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what relationship is between the cantilevered arm and the roller in either claim 15 or the independent claim 12. It appears the claim 15 should be dependent on claim 14 instead of claim 12.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1-5, 7-8 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (US 2003/0006965 A1) in view of Chinen (US 6099929).

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As to claims 1 and 11, Bohn teaches an input device (mouse 12; figure 1) comprising:

a body of said device (housing or casing 94 including a top surface 50, a bottom surface, and opposed side portions 44 and 46; paragraph 28);

electronic circuitry mounted in said body (a movement detection device or transducer; paragraph 30).

Bohn does not teach a top housing mounted over said body; and a free extending button integrally formed with said top housing; said extending button being depressible separately with respect to a remainder of said top housing; said top housing providing a cantilevered mounting of said extending button to said body of said device.

Chinen teaches a protective cover to be applied over mouse keys (column 1, lines 37-55). In one embodiment (figure 2), the sheet 14 reads on claimed top housing, either one of the free longitudinal tongues 17, 18 reads on claimed free extending button, and the adhesive strip 15 reads on claimed said top housing providing a cantilevered mounting of said extending button to said body of said device (column 3, lines 10-20).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate the protective cover of Chinen into Bohn's mouse, due to the extra protection against dust or grease to the keys and the benefit of able to provide some indicia for viewing.

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As to claim 2, Chinen's cover sheet 14 with corresponding tongues 17 and 18 are made of flexible material such as plastic and thus do not read on claimed wherein the top housing and extending button are metal.

However, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use either plastic or metal since both can provide flexibility with the proper choice of material and design.

As for claim 3, modified Bohn teaches a surface area having a scrolling wheel 18 extending through. This area reads on claimed island. Further, it is a matter of comfort and/or appearance consideration that the island would extend over an edge of said extending button.

As for claim 4, modified Bohn teaches tongues 17 and 18 that read on claimed first and second extending buttons.

As for claim 5, modified Bohn teaches a scrolling wheel 18 that reads on claimed roller.

As to claim 7, Chinen's cover sheet 14 is secured to the top surface 50 by means of an adhesive strip 15 behind the mouse keys 14 and 16.

Chinen does not teach claimed wherein said top housing curves around a back of said device and attaches to the back of said device.

However, it would have been obvious for one of ordinary skill in the art at the time the invention was made to extend the cover sheet 14 towards the back of the mouse, as this would provide more surface for indicia and further protection for the mouse.

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As to claim 8, the use of resilient bumper between said top housing and said body obviously provides a cushioning to the user holding the mouse.

Claim 12 is combination of claims 1-4 and is rejected accordingly.

Claim 13 is rejected per analysis of claim 5.

Allowable Subject Matter

6. Claims 6, 9, 10, 14 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: none of the prior arts of record teaches the limitations "a cantilevered arm supporting the roller, wherein the cantilevered arm provides a spring force to bias roller upward through the slot, eliminating the need for a return spring" of claim 6/14, "a non-metallic interior housing mounted beneath said top housing between said top housing and electronic circuitry inside said device; wherein said top housing is metal, and said interior housing isolates said metal from said electronic circuitry" of claim 9, and "wherein said top housing and extended button have a single hinge point more than halfway toward the back of said device, such that said top housing and extended button can flex on either side of said hinge point" of claim 10. Claim 16 is dependent on claim 6.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Sheng
February 19, 2004

Lun-Yi Lao
Primary Examiner

